

REMARKS

Claims 1-8 are pending.

It is believed that this Amendment is fully responsive to the Office Action dated **May 9, 2002**.

In the Specification:

The abstract is objected to due to minor informalities. The abstract has been amended, as needed, to overcome this objection.

Claim Objections:

Claim 1 is objected to due to minor informalities. Claim 1 has been amended, as needed, to overcome this objection.

Rejection Under 35 U.S.C. §103:

Claims 1 and 3 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Ohki et al. (U.S. Patent No. 5,945,652)**.

Ohki et al. discloses electrical wallet, which displays a balance of the electronic money of the IC card on the liquid crystal display part, and which being able to make payment of electronic money between individuals, between individual and bank, and between individual and distribution industry retail store through signal transfer between IC cards or between IC cards through public line or the like.

A readily identifiable distinction between Ohki and the claimed invention is the way of communicating with an external apparatus. In the claimed invention, a direct connection with the external apparatus 15 is made possible perhaps by use of a wire connector.

On the other hand, in Ohki, a direct communication with an equivalent of an external apparatus 15 is not possible. Ohki actually requires a modem 321 being connected to an electronic wallet via modem connector 331 as clearly shown in Figure 3B. To make a successful connection between the electronic wallet and an equivalent of external apparatus 15, a modem unit 321 must be installed onto the electronic wallet via modem connector 331, a telephone line must be installed between a telephone outlet and modular jack 3212 of modem 321. Once these hardware connections are completed, successful connection between the electronic wallet and the Central Office of a telephone company must be established. Thereafter, the Central Office of a telephone company must establish successful connection with the equivalent external device, then a communication between the electronic wallet and the equivalent of external apparatus 15 is made possible.

Therefore, the method and implementation of making connection with an equivalent of an external apparatus are completely different.

To highlight these technical distinctions between Ohki and the claimed invention, the features of a connecting section 14 for being detachably and directly connected to an external apparatus (15) eliminating the necessity of a central office of a telephone company have been added.

Independent claim 1, as amended, is reproduced hereinbelow for the convenience of the Office:

“1. (Amended) A portable-card-unit processing apparatus for processing data in a storage section (17a) of a card unit (17) when the card unit (17) is attached to said apparatus, comprising:

a first communicating section (23, 243) for communicating with the card unit (17);

a connecting section (14) for being detachably and directly connected to an external apparatus (15) eliminating the necessity of a central office of a telephone company;

a second communicating section (24, 244) for communicating with the external apparatus (15) through said connecting section (14);

a display section (13) for displaying at least data read out from the storage ~~unit~~ section (17a) of the card unit (17) through said first communicating ~~unit~~ section (23, 243); and

a control section (20) for controlling said first dedicated communicating ~~unit~~ section (23, 243) and said second communicating section (24, 244) so as to transfer data between the card unit (17) and the external apparatus (15) while the external apparatus (15) is connected to said connecting section (14), and controlling said first dedicated communicating section (23, 243) and said display section (13) as to read out data from the storage section (17a) of the card unit (17) and to display the read-out data on said display section (13) while the external apparatus (15) is disconnected from said connecting section (14).”

By so amending, it is believed that independent claim 1 has been placed in condition for allowance.

Section 706.01(j) of the MEP. has specifically stated that:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 466, 20 USPQ2d 1438 (Fed. Cir. 1991).”

Therefore, it is both a court position and a Patent Office position that to establish a *prima facie* case of obviousness, 1) there **must be** some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Therefore, should the Office either be unable to identified each and every aspect of the above-mentioned claimed features after taking full consideration of the asserted prior art in a way exactly applied in the outstanding Office action, or the Office recognizes that the rejection simply does not arise to a level objectively fulfilling all three criteria of establishing a *prima facie* case of obviousness, it is respectfully submitted that the obviousness rejection is defective and allowance of the claimed invention is requested.

Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over **Ohki et al. (U.S. Patent No. 5,945,652)** in view of **Takami et al. (U.S. Patent No. 6,189,782)**.

As independent claim 1 has already been amended to patentably distinguish over Ohki, all claims dependent thereon, by virtue of inherency, also patentably distinguish over Ohki further in view of whatever other references.

Reconsideration and withdrawal of this rejection are respectfully requested.

Claims 4, 7 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Ohki et al. (U.S. Patent No. 5,945,652)** in view of **Tognazzini (U.S. Patent No. 5,850,077)** and **Yanagi et al. (U.S. Patent No. 6,168,078)**.

As independent claim 1 has already been amended to patentably distinguish over Ohki. All claims dependent thereon, by virtue of inherency, also patentably distinguish over Ohki further in view of whatever other references.

Reconsideration and withdrawal of this rejection are respectfully requested.

Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over **Ohki et al. (U.S. Patent No. 5,945,652)** as modified by **Tognazzini (U.S. Patent No. 5,850,077)** and **Yanagi et al. (U.S. Patent No. 6,168,078)** and further in view of **Albaret (U.S. Patent No. 6,1489,058)**.

As independent claim 1 has already been amended to patentably distinguish over Ohki. All claims dependent thereon, by virtue of inherency, also patentably distinguish over Ohki further in view of whatever other references.

Reconsideration and withdrawal of this rejection are respectfully requested.

Allowable Subject Matter:

The indication of allowable subject matter in claim 6 is noted with appreciation. As independent claim 1 has been amended to patentably distinguish over Ohki et al., the indicated allowable subject matter in claim 6 and intervening claims is not added therein.

Prior Art Indicated To Be Pertinent To The Disclosure

The Office has provided a list of prior art indicated to be pertinent to the Applicant's invention. Consistent with the understanding as stipulated in MEP. 706.02 that only the best prior art should be applied, this list of prior art not having been applied by the Office, it is the Applicant's understanding that the Office must have considered the listed prior art to be no more pertinent than the applied prior art of record.

CONCLUSION

In view of the aforementioned amendments and accompanying remarks, all pending claims are believed to be in condition for allowance, which action, at an early date, is requested.


If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

Attached hereto is a marked-up version of the changes made by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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PATENT TRADEMARK OFFICE

Enclosures: Version with markings to show changes made

H:\HOME\AWEAVER\01\011599\08-06-02 Amendment

VERSION WITH MARKINGS TO SHOW CHANGES MADE 10/022,263

IN THE CLAIMS:

Please amend the claims as follows:

1. (Amended) A portable-card-unit processing apparatus for processing data in a storage section (17a) of a card unit (17) when the card unit (17) is attached to said apparatus, comprising:
 - a first communicating section (23, 243) for communicating with the card unit (17);
 - a connecting section (14) for being detachably and directly connected to an external apparatus (15) eliminating the necessity of a central office of a telephone company;
 - a second communicating section (24, 244) for communicating with the external apparatus (15) through said connecting section (14);
 - a display section (13) for displaying at least data read out from the storage ~~unit~~ section (17a) of the card unit (17) through said first communicating ~~unit~~ section (23, 243); and
 - a control section (20) for controlling said first dedicated communicating ~~unit~~ section (23, 243) and said second communicating section (24, 244) so as to transfer data between the card unit (17) and the external apparatus (15) while the external apparatus (15) is connected to said connecting section (14), and controlling said first dedicated communicating section (23, 243) and said display section (13) as to read out data from the storage section (17a) of the card unit (17) and to display the read-out data on said display section (13) while the external apparatus (15) is disconnected from said connecting section (14).

4. (Amended) The portable-card-unit processing apparatus according to ~~any one of claims 1 to 3~~ claim 1, further comprising a save storage section (30) for holding at least part of information that are stored in the storage section (17a) of the card unit (17),

said control section (20) being operable, when the card unit (17) is attached to said apparatus while the external apparatus (15) is disconnected from said connecting section (14), said first communicating section (23, 243) as to read said at least part of information from the storage section (17a) of the card unit (17) and to store said at least part of information into said save storage section (30).

7. (Amended) The portable-card-unit processing apparatus according to ~~any one of claims 4 to 6~~ claim 4, wherein when said card unit (17) storing electronic money defined as an electronic symbol of currency in said storage section (17a) is attached, transaction information on said electronic money is read out from said storage section (17a) and stored as said at least part of information in said save storage section (30).

8. (Amended) The portable-card-unit processing apparatus according to ~~any one of claims 4 to 7~~ claim 4, wherein said save storage section (30) is a non-volatile memory.

IN THE ABSTRACT:

The Abstract has been amended as indicated below:

ABSTRACT

~~A portable-card-unit processing apparatus for processing data in a storage section of a card unit when the card unit is attached to the processing apparatus.~~ The processing apparatus includes a first communicating section (23, 243), a connecting unit (14) for being detachably connected to an external apparatus, a second communicating section (26, 244), a display section (13), and a control section (20) for controlling the first communicating section (23, 243) and the second communicating section (26, 244) so as to transfer data between the card unit and the external apparatus while the external apparatus is connected to the connecting section (14), and controlling the first communicating section (23, 243) and the display section (13) so as to read data from the storage section of the card unit and to display the read-out data on the display section (13) while the external apparatus is disconnected from the connecting section (14). ~~This processing apparatus thereby serves as not only an information displaying apparatus for the card unit but also a card-unit reading/writing apparatus.~~